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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,862	11/25/2000	Paul Lapstun	NPT008USUS	3962

24011 7590 05/02/2006

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AUSTRALIA

EXAMINER
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NGUYEN, KIMBERLY D

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/721,862

Applicant(s)

LAPSTUN ET AL

Examiner

Kimberly D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8-10, 12, 13 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-10, 12, 13, 21, 28 and 29 is/are rejected.
- 7) ☒ Claim(s) 22-27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Amendment*

1. Acknowledgment is made of Amendment filed February 2, 2006.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 8-10, 12-13, 21, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Wright et al. (US 4,864,618; hereinafter "Wright").

Re claims 8, 21, and 29: Wright teaches a method of coding a region including applying coded data to a part of the region, the coded data indicating both a functional attribute of the part of the region and a relative location on the region, at least some of the coded data including data indicative of an identity of the region, the method comprising the steps of:

printing the coded data (78 in fig. 6A; coded number or sequence of marks) on the relative location on the region using ink that is substantially invisible to the human eye (col. 12, lines 38-47)

"...the terminal printer prints within or *under* the postmark a coded number or sequence of marks corresponding to an element of the postmark, such as the amount of postage, the terminal identification number, and/or the sender's zip code. The marks may be disguised or made invisible by printing with a magnetically or optically readable ink to deter tampering or unauthorized simulation..." (column 4, line 63 through column 5, line 6); and

printing visible content (postmark) on the relative location, wherein the visible content corresponds to the coded data (col. 12, lines 38-47);

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wherein the visible content and the invisible coded data are printed by the same printer (abstract, lines 7-12; column 4, line 63 through column 5, line 6; column 19, lines 16-32; column 20, lines 50-65.)

Re claims 9-10 and 12-13: Wright teaches the coded number or sequence of marks, which may be printed within or under the postmark, can be the amount of postage, the terminal identification number, and/or the sender's zip code (column 4, lines 63-68), which serves as a drawing field, a text field as set forth in claim.9; a location/identity (claims 10-12).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wright in view of Yagita (US 6,089,455). The teachings of Wright have been discussed above.

Wright fails to teach or fairly suggest the coded data comprising data bits represented by a radial wedge in the form of an area bounded by two radial lines, a radially inner arc and radially outer arc.

Yagita teaches the coded data comprising data bits represented by a radial wedge (e.g.,  $X_1-A_1$ ,  $X_1-A_2$ ,  $X_2-A_2$ ) in the form of an area bounded by two radial lines, a radially inner arc and radially outer arc (e.g., the concentric-circular areas E, D, C, B, A) (fig. 7; col. 6, line 49 through col. 7, line 10).

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It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the coded data with concentric-circular areas as taught by Yagita to the teachings of Wright in order to correctly and rapidly recognize the code regardless of the direction of the code (Yagita, col. 4, lines 8-11).

#### *Allowable Subject Matter*

6. Claims 22-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to specifically teach the coded data comprising a plurality of tags, wherein each tag includes six target structures consisting of a detection ring, an orientation axis target, and four perspective targets as set forth in claims 22-27.

#### *Response to Arguments*

8. Applicant's arguments filed 2 February 2006 have been fully considered but they are not persuasive.

9. In response to applicant's arguments, the recitation, such as "coding the identity of the code field," "coding the identity of the region wherein the coded data is applied, within the coded data," "at least some of the coded data include an identity of the region to which the coded data has been applied" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural

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limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

10. Furthermore, the recitation(s), such as “coding the identity of the code field,” “coding the identity of the region wherein the coded data is applied, within the coded data,” “at least some of the coded data include an identity of the region to which the coded data has been applied”, can be broadly interpreted as coded number/marks/postmark, which is coded in the region (e.g., 78, 79 in fig. 6a; col. 12, lines 38+), which is printed by visible/invisible inks as desired.

Accordingly, given its broadest reasonable interpretation, Wright and Yagita still meet the claimed invention.

### *Conclusion*

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 571-272-2402.

The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KDN

April 17, 2006